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IN THE

Supreme Court of the United States

No. 23. **October Term, 1935.**

THE BASSICK MANUFACTURING COMPANY,
Plaintiff-Petitioner,

v.

THE R. M. HOLLINGSHEAD COMPANY,
Defendant-Respondent.

Brief on Behalf of Defendant-Respondent.

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BRIEF ON BEHALF OF DEFENDANT-RESPONDENT.

STATEMENT OF THE CASE.

The writ of *certiorari* allowed in this case brings before this Court for review a part of the decree of the Circuit Court of Appeals for the Sixth Circuit. The decision of this Court is printed on pages 601 et seq. of the record and is reported in 73 Fed. (2nd) 543.

The issues before the Circuit Court of Appeals were the following:

Was defendant-respondent guilty of contributory infringement of the Gullborg patent No. 1,307,734?

Was the defendant-respondent guilty of contributory infringement of the Zerk patent No. 1,745,980?

The Court of Appeals held that defendant-respondent infringed neither patent.

Infringement of the Gullborg patent was based on the sale by defendant-respondent of two types of grease-guns, one illustrated in Plaintiff's Exhibit A attached to the Cumming affidavit (Rec. p. 26) and in Defendant's Exhibit 6, parts A, B and C, and the other illustrated in Plaintiff's

Exhibit A attached to the Beezley affidavit (Rec. p. 19) and Defendant's Exhibit 8, parts A, B, C, D and E. The Court of Appeals decided that the sale of neither of these two types of grease guns involved infringement of the Gullborg patent.

Petitioner did not, by its petition, bring before this Court for review that part of the decision which holds non-infringement of the Zerk patent. Nor did the petitioner bring before this Court for review that part of the decision which holds that the sale of the first type of grease-gun above specified does not infringe the Gullborg patent.

The sole question brought before this Court for review is whether the sale of the second of the above specified grease-guns is a contributory infringement of the Gullborg patent. (Specification of Errors, p. 34, Brief in support of Petition for Writ.)

At the hearing before the Circuit Court of Appeals the parties were agreed that, assuming the validity of claims 1, 2, 3, 4, 5, 6, 8 and 10, they were all limited to grease guns in which the coupler has in operation a "suction effect". The plaintiff-petitioner contended that claims 14 and 15 were broad enough to cover the combination with the specific grease-cup defined therein of any grease gun capable of pumping grease into such grease-cup. Defendant-respondent contended that if claims 14 and 15 were thus broadly construed they were invalid. The Court held that claims 14 and 15, as well as the other claims in suit, were limited to a grease gun in which the coupler has in operation a "suction effect".

That part of the decision of the Court of Appeals which construes claims 14 and 15 as limited to a grease gun whose coupler has a "suction effect" is not brought before this Court for review.

In the petition for writ of *certiorari* and in the brief now on file, plaintiff-petitioner apparently accepts the decision of the Court of Appeals as to the scope of claims 14 and 15 of the Gullborg patent. *The sole question raised in the petition and in the brief is a question of fact,* namely, whether the coupler of the second of the two above-named grease guns of defendant-respondent has in operation a "suction effect".

If claims 14 and 15 should be construed literally and, therefore, as sufficiently broad to cover the combination, with the specific grease-cup defined in those claims, of any old grease gun, and if these claims so construed be valid, and if the sale of any old grease guns adapted to function to pump grease into such grease cup would be a contributory infringement of the Gullborg patent, then it would become unnecessary to determine whether the Exhibit A Beezley type of grease gun has a coupler which in operation has a "suction effect", since, whether it has or not, the sale of such a grease gun, and indeed also the sale of the Exhibit A Cumming type of grease gun, would be a contributory infringement of claims 14 and 15.

However, that part of the decision which holds that none of the claims of the Gullborg patent is infringed by the sale of grease guns of the type identified herein as Exhibit A Cumming affidavit is, as above stated, not brought before the Court for review.

Nor does plaintiff-petitioner allege in its petition or in its brief that claims 14 and 15, as well as the other claims of the Gullborg patent, are not limited to grease guns having couplers which in operation have a "suction effect". The only allegation of error contained in the petition for writ is that the Court erred—

> "In finding that claims 1, 2, 3, 4, 5, 6, 8, 10, 14 and 15 of the Gullborg patent No. 1,307,734 were not infringed by the Hollingshead Company's sale of lubricant compressors and suction effect couplers of the type identified herein as Exhibit A, Beezley affidavit."

The first question that we will discuss, therefore, is whether the Court was in error in its finding of fact that the coupler of the grease gun of the Exhibit A Beezley type had in operation a "suction effect".

Plaintiff-petitioner may contend (although there is no indication of that in his brief) that he is entitled to urge that claims 14 and 15 are not limited to grease guns whose couplers have a "suction effect". We submit that there is no allegation of error that permits plaintiff-petitioner to take that position. In case, however, that this Court should hold that plaintiff-petitioner is entitled to urge alleged errors of the Court not specified in the petition or discussed in the brief, we devote one chapter of this brief to a discussion of the scope and validity of claims 14 and 15.

The Court of Appeals Did Not Err in Holding That the Sale of Grease Guns of the Exhibit A Beezley Type Did Not Infringe the Gullborg Patent in Suit.

The Gullborg patent in suit, No. 1,307,734, relates to an old art in which any ordinary pump or compressor or so-called *grease gun* is used to force grease into a *grease-cup* or "nipple" or "fitting" communicating with the bearing of any machine, for example, an automobile. The two articles are not sold in combination but separately. The defendant-respondent sells only grease guns.

The plaintiff-petitioner is the owner of patent No. 1,307,733 (Record p. 453) not in suit, for a grease-cup which

differs slightly from older grease-cups in that the old bayonet projections, extending laterally on opposite sides of the grease-cup and adapted to be engaged by the bayonet joint of the coupler element of the grease-gun, are formed by a pin which extends transversely through the grease-cup and affords a seat for the valve-closing spring of the grease-cup.

The invention of the patent in suit has been held by the courts to be an improvement in the old grease-gun; the improvement comprising a coupler element which in operation has a "suction effect", namely, the capacity, upon its detachment from the grease-cup, of sucking in grease that would otherwise adhere to the exposed outer end of the grease-cup.

Of the claims in issue of the patent in suit, claims 1, 2, 3, 4, 5, 6, 8 and 10 claim the improved grease-gun in combination with a part to be lubricated, all of the claims specifying such part in terms broad enough to include *old* grease-cups. Claims 14 and 15 (literally construed) claim the specified grease-cup of patent 1,307,733 in combination with *any* old grease gun.

The capacity of the grease-gun to perform this "suction effect" depends on two factors: namely, (1) the capacity of the sealing-disc member of the coupler that abuts against and seals against the end of the grease-cup, to advance slightly upon the detachment of the coupler from the grease-cup and create a slight suction or partial vacuum within the coupler and (2) the substantially complete release of the pressure upon the grease within the hose and coupler of the grease-gun before the detachment of the coupler from the grease-cup.

That both such factors must co-exist to maintain the charge of infringement is clear from the petitioner's brief. (See, for example, page 55.)

In the petition for the writ and the brief in support thereof, the contention of infringement by the Hollingshead large service compressor (Plaintiff's Exhibit A attached to Beezley affidavit (Rec. p. 19), and Defendant's Exhibit 8, parts A, B, C, D, E (offered p. 197, Rec.)) was based, not upon defendant-respondent's actual grease-gun, but upon a hypothetical construction (see opposite page 20 of the petition) comprising defendant-respondent's coupler associated with a pump which was operable to satisfy the second of the two specified factors necessary to support infringement.

In our reply brief, we asserted that the petitioner was without right to do this and maintained that in the actual defendant-respondent's large service compressor, namely, the Hollingshead grease-gun as represented by Plaintiff's Exhibit A attached to the Beezley affidavit and Defendant's Exhibit 8, parts A, B, C, D and E, the second of the specified factors necessary to support infringement did not exist.

The plaintiff-petitioner, in the present brief, abandons his case on the hypothetical grease gun and endeavors to demonstrate that the actual Hollingshead grease-gun satisfies both requirements.

The question in dispute is, therefore, *solely a question of fact*, namely, whether Hollingshead large service "compressor" or large service type grease-gun has the "suction effect".

The only testimony on this point in the case is that submitted by defendant-respondent. Record, pp. 196-7. While this testimony is that of an expert, it comprises not wholly or mainly expressions of opinions but consists largely of statements of fact, one of which is that in the operation of defendant's grease gun the coupler has no suctional effect whatsoever. No testimony was submitted by the plaintiff in

contravention or qualification of defendant's testimony. The appellate court presumably gave weight to this undisputed fact testimony and found as a fact that "such retraction of excess lubricant as was made to appear upon demonstration [by Mr. Williams] was slight and was apparently only that commonly incident to the movement of grease upon release of pressure". (Rec. p. 604.) The attention of the Court of Appeals was expressly directed to this alleged error of fact in plaintiff's petition for rehearing (Rec. p. 614), and in denying that petition it must be assumed that the court gave the matter its particular consideration.

So far as can be gathered from a study of plaintiff-petitioner's brief, it is not alleged that any grease gun the same as Beezley A or Defendant's Exhibit No. 8 was ever involved in any other contested or reported suit against any other defendant in which infringement was decreed as a result of a full trial of the issues, but only that the coupler element thereof was involved in such other suits (in conjunction with a different kind of pump). However that may be, the question whether, in the operation of this (defendant-respondent's) grease-gun, the coupler has a "suction effect" must be decided by the evidence *in this case*. The evidence is that it does not have a "suction effect" and such evidence is uncontradicted. The decision of the Court of Appeals made a finding of fact in accordance with that evidence. We submit that such finding of fact should not be disturbed by this court, especially in the absence of evidence warranting any different finding.

Instead of transporting to Philadelphia the large service compressor (Plaintiff's Exhibit A attached to Beezley affidavit), another of said large service compressors, taken out of stock, was produced and operated by the witness Hugo C. Gibson and testimony given as to its operation. No

question was raised as to the identity of the two grease guns. No objection was made to the offer in evidence of Defendant's Exhibit 8 or to testimony relating thereto. Plaintiff offered no testimony as to lack of identity between Plaintiff's Exhibit A attached to Beezley affidavit, and Defendant's Exhibit 8. Plaintiff offered no testimony that the Beezley A grease gun had any different construction or operation from that of Defendant's Exhibit 8.

In the brief counsel for the plaintiff-petitioner attempts, *by argument*, to supply his total lack of *evidence*. If such argument had been presented as *evidence* in support of plaintiff-petitioner's *prima facie* evidence of infringement, defendant would have been afforded an opportunity to offer *evidence* in rebuttal thereof. Since we do not agree with plaintiff-petitioner's counsel that the operation that he describes is the normal or intended operation of the grease gun, or that it is ever so operated, or that such an operation is even *possible*, or that the "suctional effect" that he describes ever occurs in the actual operation of the grease-gun, or would occur even if his described (hypothetical) operation were possible, it is certain that if such argument of counsel had been presented as evidence, it would have been controverted by evidence additional to, but entirely consistent with, the evidence that defendant-respondent has actually submitted.

We gravely doubt that the court will consider conflicting assertions of counsel with respect to the operation of an alleged infringing machine whose actual operation, under service conditions, can only be competently described by experts or by those who actually construct or actually use the machine.

The burden of supplying such evidence clearly rests upon plaintiff-petitioner, *who has failed to present any evi-*

dence at all. Since defendant-respondent, although not having the burden of so doing, presented such evidence, it can be attacked only by evidence and not by pseudo-evidence of counsel.

Nevertheless the Court may consider that counsel for defendant-respondent should express his acquiescence in or dissent from the description of the alleged operation of the Hollingshead grease-gun set forth on pages 65-66 of plaintiff-petitioner's brief. We not only deny that the grease-gun is normally so operated but assert that such mode of operation is impossible.

In the first place, it is impossible to operate the grease gun, *as illustrated* in the drawing opposite page 73 of plaintiff-petitioner's brief, to force grease into the bearing, if for no other reason than that the so-called pump 15, 16 lacks the spring-pressed check-valve at the grease outlet channel. A pump of the "reciprocating piston" type shown, minus a check-valve, is not a *pump* at all. In the Hollingshead grease-gun a single depression of the "reciprocating plunger 16" does not suffice to force grease into the high pressure bearing. Repeated reciprocations of the reciprocating plunger are necessary to build up the pressure required to force grease into the bearing. Such pressure cannot be built up unless a check-valve is provided to prevent back flow of grease during each upward retracting movement of the reciprocating piston. The normal pressure—say 150 pounds—in the reservoir R, is wholly insufficient to force grease into the bearing. The pressure required to force grease into the bearing is many times in excess of this. It may even run as high as 10,000 pounds (p. 65, plaintiff-petitioner's brief). Now a single depression of the reciprocating plunger merely increases the pressure in the hose and coupler, but not to the degree required to forcibly expel

grease into the bearing. At each upward retraction movement of the reciprocating plunger 16 the check-valve prevents the grease backing up into the pump chamber (both by the built-up pressure in the hose and by the suction in the pump chamber when the piston is retracted) and maintains in the hose and coupler the somewhat higher pressure established therein by the previous downward advance of the pump plunger.

After repeated reciprocations, a sufficient pressure is built up in the hose and coupler to force the grease into the bearing.

It must be borne in mind that the volumetric capacity of the hose and coupler is not fixed and invariable. The hose 19 (see picture opposite page 73 of brief of plaintiff-petitioner) is capable of expansion longitudinally and transversely and does expand to accommodate the small added increments of grease which are forced into the hose at each downward advance movement of the reciprocating plunger.

After the bearing is lubricated the plunger 16 remains down during the detachment of the coupler from the grease-cup. Due to the high pressure still existing in the hose and coupler, the only effect of the advance of the cup 26, as the coupler is unscrewed from the grease cup, is to provide a small space to receive some of the excess grease which is packed into the hose and coupler. But the space is too small to hold all such excess grease. The remainder exudes through the orifice in cup 26 and must be cleaned off.

The supposititious vacuum inside the cup never forms, for the reason that the pressure upon the grease is not released prior to detachment of the coupler.

If, prior to detachment of the coupler from the grease cup, the plunger 16 were raised slightly from the position

shown in Fig. 9 to that shown in Fig. 10, it would not release or even reduce the pressure within the hose and coupler.

It appears, however, that while the pump of Defendant's Exhibit 8 contains a check valve, in Plaintiff's Exhibit A attached to the Beezley affidavit the check valve of the pump is missing. Counsel for plaintiff-petitioner asserts that no check valve was ever there. We assert that of course it was there when sold. This exhibit, as well as numerous other physical exhibits, has been on file for nine years. The various exhibits have been taken apart and reassembled repeatedly, and it could hardly be expected that they would all be in precisely the same condition as when filed.

The difficulty of assuming that the pump of Plaintiff's Exhibit A attached to the Beezley affidavit lacked a check valve, when sold by defendant-respondent, resides in the fact that the so-called pump ceases to be a pump at all, making the grease gun wholly inoperative. It necessitates the assumption that the mere depression of the plunger 16 from the position shown in Fig. 8 to the position shown in Fig. 9 would suffice to both multiply the pressure to the extent required to force the grease through the hose and coupler into the high pressure bearing and displace the volume of grease necessary to fill such a bearing. It is not conceivable that it would do either. If, in the actual operation of the pump, the reciprocating plunger 16 should be repeatedly reciprocated, then, in the absence of a check valve, at each upward movement of the plunger the vacuum thereby created under the plunger would draw the grease back into the pump barrel and again restore in the hose and coupler the initial pressure of approximately 100 lbs.

Even if we assume the absence of a check valve and that somehow the bearing has been filled, if the pump

plunger 16 should be slightly retracted, as shown in Fig. 10, the resultant drop in pressure in the hose and coupler would be comparatively insignificant and certainly would not remotely approximate the substantially entire release of pressure which is necessary in order to enable the coupler to have any suctional effect.

The demonstration before the Court of Appeals for the Sixth Circuit alluded to in the opinion of the Court (Record page 604) was made with a pump without a check valve, and of course not under service conditions. The court nevertheless held that "such retraction of excess lubricant as was made to appear upon demonstration was slight and was apparently only that commercially incident to the movement of grease upon release of pressure". Rec., p. 604.

In respect to the operation of the Hollingshead large service compressor or grease gun, we have the following conditions:

No evidence whatsoever in support of plaintiff-petitioner's contention that the coupler in such compressor, by any possible mode of operation, has or can have any "suction effect".

Testimony on the part of defendant-respondent that in a large service compressor alleged by it to be a substantial duplicate of the one offered in evidence by the plaintiff the coupler has and can have no "suction effect".

No objection by plaintiff-petitioner to the offering in evidence of this duplicate grease-gun; no objection to testimony taken relating thereto; no testimony in rebuttal thereof either to show the lack of identity between the two grease-guns or that the grease-gun offered in evidence by plaintiff-petitioner had any different mode of operation; and an express finding of fact by the Court of Appeals for

the Sixth Circuit that defendant-respondent's grease-guns were destitute of the "suction effect" and therefore without the sole alleged novel characteristic of the Gullborg grease-gun.

We submit that there is no reason why this Court should depart from what we understand is its established rule, namely, not to review findings of fact of the court from which an appeal is taken.

For some reason, not clear to counsel for defendant-respondent, plaintiff-petitioner devotes a part of its brief to pointing out the withdrawal by defendant-respondent of certain assignments of error in another appeal taken in 1928, No. 5397, which is *not* the appeal which resulted in the decision to which the petition for writ of *certiorari* in this case is directed. The appeal which resulted in the decision of the Sixth Circuit Court of Appeals which plaintiff-petitioner seeks to have reviewed by this Court is the appeal taken by defendant-respondent in 1932 and is Appeal No. 6419. No useful purpose would be served by discussing the assignments of error in this older appeal, or by explaining why certain assignments were withdrawn therefrom, or by explaining the structures of defendant-respondent involved therein, or by attempting to answer the inferences which plaintiff-petitioner's counsel seeks to draw therefrom. It suffices to say that in the appeal taken in 1932, which alone was before the Court, the assignments of error alleged, specifically and generically, invalidity of all the claims of the Gullborg patent in suit, and non-infringement of all of them by both types of Hollingshead grease-guns.

Claims 14 and 15, if Construed as Not Limited to a Grease Gun Whose Coupler Has a Suction Effect, Are Invalid.

With respect to claims 1, 2, 3, 4, 5, 6, 8 and 10 of the patent in suit, at the hearing before the Circuit Court of Appeals, both parties were in agreement that they are limited to a grease-gun the coupler element of which, in the operation of the grease-gun, has a "suction effect".

We do not know what position the plaintiff-petitioner in this case will take in the *Rogers v. Alemite* case with respect to claims 14 and 15. In the instant case the Court of Appeals for the Sixth Circuit held that claims 14 and 15, as well as claims 1-6, 8 and 10, are limited to grease-guns with "suction effect" couplers. The Court held that since the coupler of the other Hollingshead grease-gun (Plaintiff's Exhibit A attached to Cumming affidavit) concededly had no "suction effect", claims 14 and 15, as well as the other claims, were not infringed by this grease-gun. To this interpretation of claims 14 and 15, plaintiff-petitioner, in its brief, as well as in its petition for writ of *certiorari*, takes no exception. Since plaintiff-petitioner, in its petition for the writ, does not ask this Court to review that part of the decision of the Court of Appeals for the Sixth Circuit which holds that the Exhibit A Cumming type of grease gun is not an infringement of claims 14 and 15, it, by necessary inference, accepts that Court's interpretation of claims 14 and 15. The same necessary inference follows from its failure, in its brief filed in this Court, to ask for any other interpretation of claims 14 and 15. If we are correct in this understanding of plaintiff-petitioner's position, or in this interpretation of the necessary effect of plaintiff-petitioner's failure to ask a review of the appellate court's decision on *both* types of defend-

ant-respondent's grease guns, there is no occasion to discuss claims 14 and 15 at all, since if claims 1-6, 8 and 10 are not infringed, claims 14 and 15 cannot be infringed. If, however, the plaintiff-respondent in the *Rogers v. Alemite* case shall take the position that claims 14 and 15 are not limited to a combination wherein the coupler of the grease gun has a suctional effect but are broad enough to include within their scope the combination, with a specific construction of grease cup, of *any* old grease gun, whether or not the coupler has a suctional effect, and if this Court should decide that the plaintiff-petitioner, in the instant case, has the right, which we believe it has not, to contend for this broad interpretation of claims 14 and 15, and if, finally, this Court should also decide that claims 14 and 15 are entitled to be thus broadly construed, then it becomes necessary for us to attack their *validity,* since if claims 14 and 15 be thus broadly construed and also held valid, the sale by defendant-respondent of the Beezley Exhibit A type of grease gun, even though the coupler may have no suctional effect, may be held to be a contributory infringement.

We may say that neither plaintiff-petitioner nor defendant-respondent is particularly interested, except as it may effect taxation of costs, in defendant-respondent's right to use its obsolete and discarded large service compressor (Plaintiff's Exhibit A attached to Beezley affidavit) and that defendant-respondent is not remotely concerned as to its right to use, in such service compressor, a reciprocating plunger type of pump which, without a check valve, cannot function as a pump. The fundamental issue in this case is (or was) the question of the validity or scope of claims 14 and 15, that is, whether plaintiff-petitioner has the legal right, based upon those claims, to prevent defendant-respondent and the public generally from

selling old and unpatented grease guns to garages and filling stations, for use in pumping grease into the bearings of automobiles, including, of necessity, those automobiles that are equipped with plaintiff-petitioner's patented grease cups. We assume that this Court allowed the writ on the assumption that this was the issue involved in both the instant case and the *Rogers v. Alemite* case.

Since we have difficulty in conceiving that counsel for plaintiff-petitioner intends to confine its oral argument to the minor issue raised in its petition and discussed in its brief, we must assume that counsel's plan of campaign is, in the instant case, to keep the only fundamental issue (validity or scope of claims 14 and 15) in the background in order that he may argue that issue in the *Rogers v. Alemite* case, the record in which, particularly in its disclosure of the prior art, is by no means as complete as in the instant case, in the hope that, by thus avoiding confronting the real prior art as developed in the record in this case, he may stand a better chance of prevailing on the fundamental issue.

To this strategy we cannot reasonably object unless counsel shall take the position that the Hollingshead Company, in the instant case, would be bound by any decision in *Rogers v. Alemite* upholding the validity of claims 14 and 15, broadly construed as plaintiff-petitioner seeks to have it construed in that case. Plaintiff-petitioner, we submit, cannot take such a position. To entitle it to take such position, it must first have asserted, in the instant case, that the Court erred in its restricted interpretation of claims 14 and 15, and that the Court erred in holding that the sale of Exhibit A attached to Cumming affidavit (which embodies a coupler admittedly incapable of a suction effect) did not contributorily infringe claims 14 and 15; and fur-

ther it must have developed its position on this fundamental issue in its brief in order that defendant-respondent might be apprised of defendant-respondent's position in advance of the preparation and filing of its own brief.

If, contrary to our view, although the question of the validity and scope of claims 14 and 15 is not raised in the petition and the brief in support thereof, that question is in issue in the present case, then we contend that claims 14 and 15, if construed literally as being for a combination of an improved grease cup with any old grease gun, are invalid, and we submit the following argument in support of this position.

Where patent claims, literally construed, cannot be sustained as valid, the courts, including the Supreme Court, have, in many cases, held them invalid; while in other cases they have held them to be valid by importing into them some novel feature described in the specification and not expressly recited in the claims. In the instant case, we did not presume to instruct the Court of Appeals for the Sixth Circuit whether to construe claims 14 and 15 literally and hold them invalid or to construe them as limited to a grease gun whose coupler has a suction effect operation and to hold them not infringed; but we did most emphatically urge that the court must do one or the other. We so convinced the court. It adopted the alternative of importing into claims 14 and 15 an unexpressed limitation and held them not infringed.

If, however, it is sought to convince this Court that the claims are entitled to the broadest interpretation of which their language is susceptible, that is, to cover the combination of the specific grease cup of patent No. 1,307,733 in combination with any old grease gun, then we submit that the claims, so construed, are necessarily in-

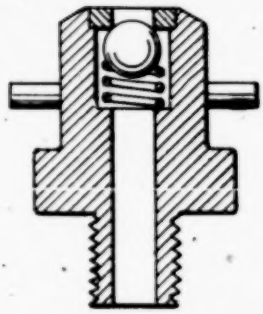
valid. We base our contention on a long line of cases which hold that a patentee cannot, by the subterfuge of claiming the combination of two elements, one of which is an old article of commerce, deprive the public of the right to continue to make and sell such old article of commerce on the theory that such manufacture and sale would constitute a contributory infringement. More specifically, we invoke the application to the present case of the well established principle of patent law that where a combination is old and well known the patentee, by merely improving one element of the combination, cannot secure a valid patent for the old combination containing such improved element. He must rely, for his patent protection, on a patent for the improved element.

Claims 14 and 15 are directed to "The combination with a grease cup . . . of a grease pump . . .". This combination is a very old combination and is disclosed in numerous patents of the prior art, including—

Laskey and Arnold	U. S. Patent	242,141	Rec. p. 427
Stedman et al.	U. S. Patent	456,295	Rec. p. 433
Winkley	U. S. Patent	1,201,414	Rec. p. 442
Winkley Reissue	U. S. Patent	14,667	Rec. p. 447
Seng	U. S. Patent	1,322,357	Rec. p. 456
Seng	British Patent	3028 of 1915	Rec. p. 467
Alley	British Patent	21893 of 1906	Rec. p. 471

In these patents the grease pump was employed for injecting, under pressure, grease to parts of machines requiring lubrication, the coupler of the grease pump being applied to grease cups on said machines communicating with such machine parts. Even the bayonet joint connection between the coupler and the grease cup was old. The sole novel feature set forth in claims 14 and 15 is *the grease*

GREASE CUP OF
ALLEY BRITISH PATENT
RECORD PAGE 471



GREASE CUP OF
GULLBORG PAT. Nº 1307734
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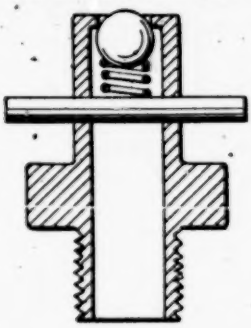
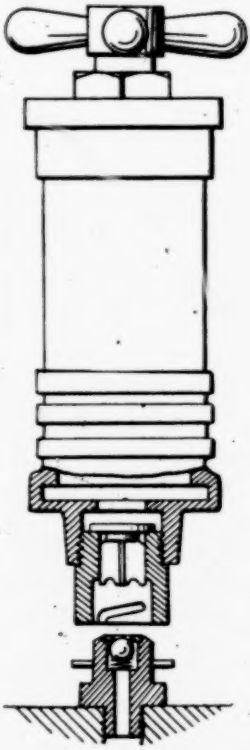
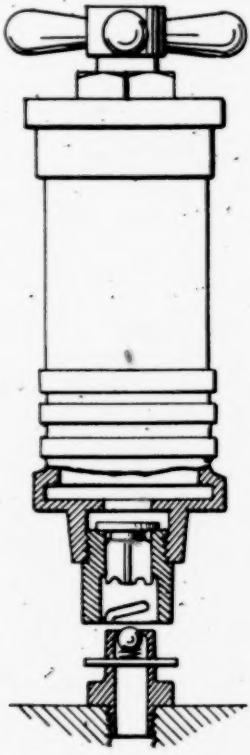


GREASE GUN OF ALLEY PAT.
APPLIED TO ALLEY'S GREASE CUP



GREASE GUN OF ALLEY PAT.
APPLIED TO GULLBORG'S GREASE CUP



cup per se. Instead of, as in the ordinary bayonet joint, forming the members 31 (see fig. 3 of the Gullborg patent in suit, page 411, Record) for engagement with the bayonet slot 22 of the coupler (see fig. 2) as projections on opposite sides of the grease cup, the members 31 are formed by a pin which extends through the grease cup and affords a bearing for the spring (see fig. 4).

The Alley British patent (Record, p. 471) is an illustration of such an old combination. While the drawing shows a screw threaded connection between the coupler and the grease cup, a bayonet joint is a well recognized mechanical equivalent, and indeed the Alley patent specification states (bottom of page 2 and top of page 3):

> "It is obvious that the means for securing the pump upon the lubricator [grease cup] may be modified —for example, instead of a coarse pitch screw a bayonet or like catch may be used—and that the form of valve used in its nozzle may be varied."

That this meagre improvement in a mechanical detail of the grease cup involves inventive genius is open to serious doubt, but there is no occasion to debate or resolve this question, since this detail improvement—whether inventive or not—forms the subject matter of a separate patent, No. 1,307,733 (Rec. p. 453).

This improved and separately patented grease-cup had no other possible use than to coact with the old and well known pump and conduit, e. g., the pump and conduit of the Alley patent, which, when provided with a bayonet joint, as Alley describes, is provided with "means coacting with the ends of the pins for detachably connecting the discharge end of the said conduit with said grease cup".

Obviously patent No. 1,307,733 exhausted the possibilities of patent protection for this improvement. But in

claims 14 and 15 of the patent in suit Gullborg claims, as a separate and independent invention, precisely the same cup in combination with the old and well known grease pump.

In order that the Court may at a glance perceive the identity between the alleged inventions of the two patents, we quote, side by side, claim 14 of the patent in suit and claim 4 of the Gullborg patent 1,307,733:

Claim 4 of Patent No. 1,307,733. (Rec. p. 455)	*Claim 14 of Gullborg Patent in Suit.* (Rec. p. 415)
"4. A grease cup comprising a tubular member having one end flanged inwardly to provide a closure seat, a closure, a pin extending through said tubular member and on both sides thereof, and a spring confined between said pin and closure and tending to hold said closure on said seat."	"14. The combination with a grease cup comprising a tubular member having one end flanged inwardly to provide a closure seat, a closure, a pin extending through said tubular member and from both sides thereof, and a spring confined between said pin and closure, and tending to hold said closure on its seat, of a grease pump having a discharge conduit, and means coacting with the ends of said pin for detachably connecting the discharge end of said conduit with said grease pump [cup]*."

Claim 15 does not substantially differ from claim 14.

It will be observed that claim 14 of the patent in suit claims the pump element in such broad and comprehensive terms as to cover any imaginable pump adapted to coact

*The word "pump" at the end of claim 14 is a misprint; it should be "cup".

with a grease cup; that the claimed combination is also old, *the only feature distinguishing from the prior art being the specific construction of the grease cup,* all possible patent protection for which was exhausted by the issue of patent No. 1,307,733.

We repeat that it is an established principle of patent law that where an old combination is altered by improving one element thereof, the construction and operation of the combination being otherwise wholly unchanged, a valid patent may be secured for the improved element (if it involves invention), but the old combination cannot be repatented by reclaiming it with the improved element substituted for the old element.

The Court will at once perceive that if this principle of patent law were not applied, the inventor would be given a degree of patent protection wholly incommensurate with his invention.

The inventor would receive *two* patents for *one* invention.

He would be able to suppress the manufacture, use and sale of unpatented articles belonging to the public domain.

The last consequence cannot be better illustrated than in the present case, wherein precisely that consequence has occurred. For many years prior to the issue of the patent in suit the public was free to make, use and sell grease guns. A typical grease gun comprised, of necessity, a pump having a discharge conduit provided with means adapted to coact with a grease cup for detachably connecting the discharge end of the conduit with the grease cup, precisely as claimed in the patent in suit. The plaintiff-petitioner alleges that it has sold hundreds of millions of grease cups or pin fittings of the construction claimed in patent 1,307,733. The public, obviously, had the right to use these old grease guns

to supply grease to the patented grease cups. But when it was attempted to do this, the public was confronted with the patent in suit, wherein these same independently patented grease cups were again claimed in combination with any old grease gun. The manufacturer, vendor and user of these old grease guns was thereupon sued as a contributory infringer, and in many cases he was enjoined as such. If, therefore, claims 14 and 15 have the broad scope for which plaintiff-petitioner contends, plaintiff-petitioner is entitled to suppress the manufacture, use and sale, not only of grease guns with suctional couplers, but of *all* grease guns, because, obviously, every maker and vendor of a grease gun knows that, in view of the hundreds of millions of plaintiff-petitioner's grease cups that are in use, the vendor will inevitably apply such grease gun to such grease cups for the purpose of lubricating automobiles and other machines equipped with such grease cups.

And this is precisely the monopoly which plaintiff-petitioner seeks to establish and which, to a large extent, by the colossal campaign of oppressive litigation which counsel for plaintiff-petitioner details in his brief, it has already established. It seeks to monopolize, and has to a large degree monopolized, not only the grease *cup* market, but also the grease *gun* market irrespective of whether such grease gun embodies any patentable feature embodied in the grease gun of the patent in suit.

We submit that this is an unjust and unlawful extension of the patent monopoly to which plaintiff-petitioner may be entitled.

The following cases illustrate the well-established principle that where a patentee improves an element of an old combination without effecting the function and operation of the combination he can patent only the improved element

and cannot repatent the old combination including the improved element.

In *Underwood v. Gerber*, 149 U. S. 224, the patentee, as in the instant case, obtained two patents, one for a "combination" and the other for an element of the combination; the two patents being consecutively numbered and issued on the same date. The first was for an improved coating composition for "carbon" or "semi-carbon" paper. The second was for the combination of that coating composition and the paper. Such combinations of paper and coating compositions were old. Suit was on the second or combination patent. Judgment for the defendant below was affirmed. The second patent was held invalid in view of the first and the prior art showing the broad combination to be old.

In *Heald v. Rice*, 104 U. S. 737, the patent in suit covered a specific mechanical combination for utilizing straw as boiler fuel. The general combination was old, i. e., a specific straw-feeding apparatus attached to a boiler. The patent in suit was for the combination of that straw-feeding attachment with an improved boiler, one with reversible flues which handled the products of combustion in a better way. The patent was held invalid. The reversible flues added to the boiler did not affect the combination. The straw-feeding attachment attached to the boiler functioned independently of the manner of conducting away the products of combustion. The Court said at page 754:

> "If there is any superiority in the return flue boilers used with this attachment as a straw-burner over the fire-box boiler when used in the same way, the superiority is due not to any difference in the straw-feeding atfachment, nor in the mode of its operation, nor to any new feature of the combination, but merely to the superiority of the return flue boiler itself . . ."

In *Carbice Corporation of America v. American Patents Development Corporation*, 283 U. S. 27, the plaintiff's patent covered a transportation package consisting of a protective casing having packed therein a quantity of solid carbon dioxide (popularly called "dry ice") with a quantity of freezable product in proximity to the carbon dioxide, the solid carbon dioxide being in the middle of the package with the material to be refrigerated disposed around it.

Solid carbon dioxide was old and the defendant sold it knowing and intending that it should be used by the purchaser in order to complete the transportation package covered by the claims, and such transportation package was so completed. The owner of the patent sued the defendant for contributory infringement. The Court of Appeals for the Second Circuit gave the plaintiff a decree and it was reversed by the Supreme Court.

> "Relief is denied because the Dry Ice Corporation is attempting, without sanction of law, to employ the patent to secure a limited monopoly of unpatented material used in applying the invention." 283 U. S., pages 33-34.

The Court also stated (note, p. 34):

> "In such cases the attempt to use the patent unreasonably to restrain commerce is not only beyond the scope of the grant but also a direct violation of the Anti-Trust Acts."

In *Morgan Envelope Co. v. Albany Perforated Wrapping Paper Co.*, 152 U. S. 425, the patented combination was for a paper holding fixture and the roll of paper held by it. Defendant sold rolls of paper for use in the fixture of the patented combination and was held not to be liable for contributory infringement.

General Electric Co. v. Ohio Brass Co., 277 Fed. 917 (Circuit Court of Appeals, Third Circuit), is another case on all fours with the present case. There were two patents, one to Hewlett, No. 1,110,934 (not in suit), for a novel electrical insulator comprising discs flexibly connected in series, the other to Hewlett & Buck, No. 925,561 (in suit), for the combination of towers provided with cross-arms, and conductor spans freely suspended between the cross-arms by the series of flexibly connected disc insulators of the said Hewlett patent.

The only novel element of claim 6 was the novel and independently patented insulator. The Court proceeded to discuss the question whether this insulator could, in combination with common expedients in the art, be the subject of invention. It was held that it could not be, the Court stating (pp. 924-5, italics ours):

> "As the insulator in the combination of claim 6, particularly described in the specification and displayed in the diagrams, is the insulator of the Hewlett patent, or an insulator distinctly of its type, *we have the question whether the Hewlett insulator,* or one falling within its description, *can in combination with common expedients of the art be the subject of invention.*
>
> "Turning to claim 6, we find, as we have said before, the invention to be a combination of three elements: *First, towers provided with cross-arms; second, an electric conductor; and, third, disc insulators flexibly connected in series supporting the conductor,* thereby producing as a result its free suspension. 'Towers provided with cross-arms' were not new. At any rate, they are the equivalent of poles with cross-arms. Poles with cross-arms are an expedient of the art as old as the art itself. Current conductors, of course, are an expedient as old as poles. *The only other*

element is the insulator, and that insulator is intended for use only in suspended connection between cross-arm and conductor. Thus there is a *combination which embodies a specific element of suspended insulator in assemblage with expedients of the prior art, which together produce no function other than that which the suspended insulator would itself produce when in operation with these ordinary expedients of the art.*

. . . . . .

Whether used for one purpose or the other, or for both purposes, *such an insulator* in overhead suspension *can be used*—so far as we have been shown or can imagine—*only in connection with the very expedients of the art named as elements of the patent combination. At least, claim 6 discloses use of the insulator only with these expedients.* There must be a tower or pole with a cross-arm from which to suspend the flexible insulator at one end and a current conductor to be appended to the insulator at its other end. *Without these two expedients the insulator cannot work. This being true, can there be invention in a combination of three elements, when two of them, separately free to everyone, are indispensable to the functioning of the third?* Or, stated differently, *is there invention in a combination which produces no result other than that produced by one of its elements operating in the only way possible for it to operate—that way being through expedients common to the art?* . . . The complainant says here is invention. With this we cannot agree because: *First, we do not find a combination which in the patent sense is new. Nor can we find such a combination useful beyond that of the insulator itself with the expedients of the art open to it—expedients without which the insulator is useless.*"

Langen v. Warren Axle & Tool Co., 184 Fed. 720 (C. C. of A., *Third Circuit*), is another decision that is exactly

in point. The claim of the patent was for a pair of grab hooks, of a specific and presumably novel and patentable construction, with a draft device. The Court held that the claim was invalid for each of two reasons: first, that as originally presented, the claim was for the novel grab hook; and, second, that that being the only invention the patentee had made, he could not have a valid claim for a pair of the novel grab hooks associated with a draft appliance because grab hooks of the prior art had been arranged in pairs and associated with a draft appliance. The Court stated (p. 721):

> "The grab-hooks and draft appliance of the patent, in combination, coact as grab-hooks and draft appliances have always done. The *grab-hook of the patent,* by reason of its peculiar construction and form, *is very probably an improvement of no little utility. But the patentee cannot, merely because of that fact, have a patent for a combination which shall have, as one of its elements, a pair of such grab-hooks. He did not invent the combination. He invented, if he invented anything, an improved grab-hook.*" (Italics ours.)

In *re Ratican,* 1911 C. D. 267, Court of Appeals, District of Columbia, the actual invention was in the nozzle of a street sprinkler, but the inventor claimed the right to a patent for the combination of his new nozzle with old street sprinkler elements. The Court stated:

> "It will be observed that the alleged invention is for a combination of elements. Appellant in his brief contends that:
>
> > 'He has "reorganized the Ottofy Street flushing machine by replacing the separate flushing and sprinkling nozzles therein with an improved form of nozzle particularly adapted for flushing purposes, and capable of use as a sprinkling-nozzle as well".'

"In other words, *appellant contends that by improving one of the many elements in a combination he is entitled to a combination patent instead of a patent for a specific invention.*

". . . *Assuming,* for the purpose of this case only, *that the improvement in a nozzle heretofore used in street-sprinkling and street-flushing carts amounts to invention,* we fully agree with the tribunals of the Patent Office that *appellant is not entitled to a patent for a new combination for the obvious reason that his combination is not new at all. He has merely substituted one nozzle for another . . . He has merely taken the nozzle of the prior art, made specific changes therein, and then restored it to its former position in the combination.* One nozzle of the prior art was effective for street-cleaning and another for street-sprinkling. When his nozzle is used for either purpose it operates exactly as did the nozzle of the prior art. *If appellant has made an improvement upon the nozzle of the prior art he is entitled to be protected in the use of his invention, but he is certainly not entitled to a patent on a new combination merely because he has improved a single element of that combination.* (In re McNeil, C. D., 1902, 563; 100 O. G., 2178; 20 App. D. C. 294.) *He has improved an element of but has not made a new combination.*" (Italics ours.)

In *Radio Corporation v. Lord,* 28 Fed. (2d) 257, the Court of Appeals for the Third Circuit had before it a patent for a new combination, namely, a certain electrical mechanism and a vacuum tube. The vacuum tube *per se* was old. The Court, in its opinion, said (p. 260):

"*A single old element, whose patent monopoly has expired, cannot be put into a new patented combination as a constituent element, and thus have its individual monopoly revived for seventeen years more.* This

would be a new method of securing a patent, or a means of evading the patent law, by doubling the length of the life of a patent. A patent may not be secured on a single element by inclusion. The vacuum tubes are an element in the electrical circuits licensed under the contracts. It is these circuits, as such, and not the single unpatented elements, that are protected. *While the defendant has the exclusive right to manufacture, lease, and sell the combination, it does not have the right to withhold from the manufacture, use, and sale by others a single one of the elements,* composing the circuits, *which is no longer protected by a patent.* In other words, *a patentee may not prevent the individual manufacture, use and sale of a single unpatented element, which the world is free to make, use and sell, by simply including it as an element in a new patented combination.* To put it differently, *the inclusion in a patented combination of an unpatented element does not give the patentee of the combination a monopoly of each element, and the exclusive right to make, use, and sell that element, independent of the combination. So long as the* patent covering vacuum tubes was in existence, the patentee of this element of the combination was protected, and it could not be included in the combination without a license to do so; but, when the patent on this tube element expired, the rights, which were theretofore vested in the patentee, became the property of the public, and not of the patentee of the combination." (Italics ours.)

In *Backstay Co. v. Hamilton,* 262 Fed. 411, the Circuit Court of Appeals for the First Circuit had before it a patent containing claims for an improved welt and also claims for a welt in combination with the article to which the welt was applied. The Court found the claims for the improved welt anticipated and those for the combination invalid, stating (p. 412 and p. 414):

> "It does not seem to me that the third and fourth claims are valid; the invention, if any, resides in the welt and cannot be held to extend to and include any and every article to which the welt may be attached."

These same claims later came before the Court of Appeals for the Seventh Circuit in *Backstay Co. v. Zenite Co.*, 293 Fed. 23. In this case the claims for the welt were held valid but the claims for the combination were held invalid, the Court stating (p. 24):

> "With the conclusion reached as to claims 3 and 4 of the device patent we are likewise in accord. Whatever of novelty there is resides wholly in the welt itself. There is not the suggestion of a new or different result flowing from the combination of this welt with the article to which it is attached. Any one of numerous welts long in the art could be employed where this one is used, and when applied the combined result would be the same. Whatever difference there is between this *and the other welts would be wholly* in the welt itself, whereby in this it is more readily applied, and the tack or other fastening means more simply and effectually concealed."

In *Warner Typewriter Co. v. Webster Co.*, 144 Fed. 405, the defendant sold typewriter ribbons, wound on spools, to users of Underwood typewriters. It was sued for infringement of a patent containing combination claims including the ribbon spools. Defendant's spools were adapted to be used in the patented combination and defendant knew that such use was intended. Plaintiff claimed that defendant was a contributory infringer. The Court, however, refused to take that view, holding (pp. 407 and 409) that the spool element of the Underwood typewriting machine was one common to and necessary for all typewriting machines. The Court pointed out the inequitable consequences that would

flow from accepting plaintiff's contention that defendant was a contributory infringer, stating (p. 409):

> "If complainant's contention is correct then every owner of an Underwood typewriting machine must purchase ribbons and spools of the complainant's, and pay any price therefor they fix, and, as a result, complainants have not only a monopoly of the machine itself, but of the supplies, inked ribbons, that must be used with it, and this without any license restriction in the sale, and without a patent for the spool and ribbon in combination, or for either alone. This mode of creating monopolies has just been condemned by the Circuit Court of Appeals, Second Circuit (145 Fed. 933*), even where there is a license restriction, in reversing Cortelyou v. Charles Eneu Johnson & Co. (C. C.) 138 Fed. 110. To sustain the contention of the complainants will, in effect, give them a monopoly, not only of the patented machine, but of an unpatented article, inked typewriter ribbon, now in common use, and as necessary to the general *public as ink itself.*"

In *Troy Wagon Works Co. v. Ohio Trailer Co.*, 274 Fed. 612, the patent was for the combination of an automatic locking device with old steering elements of vehicles. The Court of Appeals for the Sixth Circuit held that—

> "It is clear from the evidence in this case that the automatic locking device of Eccard & Smith functions in identically the same way as the automatic locking devices in the prior patent art, and that the other elements in this combination produce no new or different result in combination with this automatic locking device than produced by these elements when locked by any other means. It necessarily follows that *the combination* of an automatic lock with the old steering elements of vehicles of the character described in this patent does not constitute invention" (citing numerous cases) (p. 621).

*Cortelyou v. Charles Eneu Johnson & Co., 145 Fed. 933 (C. C. A. 2d).

In *Wall Pump & Compressor Co. v. Gardner Governor Co.*, 28 F. (2d) 334, Gardner, the patentee, claimed the combination with an air compressor of an electrically controlled automatic device for starting and stopping the air compressor and when the compressor was at rest automatically opening the valve and blowing out the precipitated oil and moisture accumulating in the line of compression. This automatic device had been previously patented by one Wilboken. The Court of Appeals for the Seventh Circuit held that there was no invention in the combination, stating (p. 338):

> "Wilboken's device had no utility of itself, but only in connection with air compressors and similar mechanisms. With this device in quite general use, can it be said that invention was involved in buying it in the open market and using it in combination with the very sort of structure in which it intended to be incorporated? It serves in this combination no different purpose from that for which Wilboken made and sold it as an article of commerce, and we do not see how Gardner's incorporation of it gave his machine an advantageous status in the art as a combination."

In *Harvey-Hubbell v. General Electric Co.*, 267 Fed. 564, the Court of Appeals for the Second Circuit had before it two patents dated the same day and numbered consecutively, as in *Underwood v. Gerber* and as in the instant case. One patent, No. 774,250, was drawn to a combination of a plug and cap. The other patent, No. 774,251, covered the plug *per se*.

The Court found that the gist of the invention, as defined in the claims in suit, *was in the construction of the plug*, and that the cap was merely any kind of a cap that would go with that novel plug. The defendant was manu-

facturing a cap which was designed and adapted to fit the plaintiff's plug and which cap, as above noted, was included as an element of the claim defining the novel plug.

The Court concluded that if the claims were read so as to cover defendant's structure they would be void over the prior art. In this Harvey-Hubbell case, like the present case, the defendant had sold an element of the combination claimed, namely, the portable *cap* which could make connection with the other elements of the combination supplied by the plaintiff, namely, the wall *plugs*, wherever the latter might be located, and the combination was not completed until the user made the connection.

The portable *cap* was held to be non-infringing although it completed the combination claim. The case of *Leeds & Catlin v. Victor Company*, upon which plaintiff-petitioner in the instant case may rely, was distinguished from in the Harvey-Hubbell case.

The Edison Electric Light Company, et al. v. Peninsula Light, Power & Heat Company, et al., 101 Fed. 831, was decided by the Circuit Court of Appeals for the Sixth Circuit, on which sat Justices Lurton and Day. Edison had secured a patent on a new system of electric wiring—and later developed an improved transformer for use with that system. He secured a patent for the transformer and in the transformer patent in addition to specific claims to the transformer he secured broad claims to the combination of any old transformer in his new wiring system.

His licensee had wired a hotel for the new system, installed an Edison transformer, and supplied current to the hotel. It should be noted that the complete combination was originally sold and installed including a transformer.

Later the hotel desired to buy current from an independent source (the defendant) who put in its own transformer and thereafter supplied to the hotel current which was used in the Edison wiring system according to the Edison teaching. Bill for contributory infringement was dismissed.

The effect of the decision was to prevent an attempt at monopoly in unpatented transformers based on a combination claim for a new system of wiring and any transformer. It was arrived at in terms of implied license, although it should be noted in this connection that the entire combination had originally been sold by the patentee's licensee. The Court said, at page 836:

> "But there may be circumstances under which the sale by a patentee of one patented article will carry with it the right to use another in cooperation with the first, although the thing be covered by a second patent. Thus, if the article sold be of such peculiar construction as that it is of no practical use unless it be used in combination with some subordinate part covered by another patent of the vendor, the right to use the latter in cooperation with the former might be implied from circumstances. It is a general principle of law that a grant necessarily carries with it that without which the thing granted cannot be enjoyed. The limitation upon this is that the things which pass by implication only must be incident to the grant, and directly necessary to the enjoyment of the thing granted. The foundation of the maxim lies in the presumption that the grantor intended to make his grant enjoyable."

All of the patents involved in the cases above discussed are essentially of the same character as that of the patent in suit so far as the alleged invention thereof is literally defined in claims 14 and 15. Since a vast number of

legitimate combination patents are granted from week to week by the Patent Office, it is inevitable that a limited number of claims for such uninventive pseudo-combinations should escape through the meshes of the examination, due either to a lack of adequate knowledge by the Examiner of the practical commercial art or to the Examiner's imperfect knowledge of patent law. The principle for which we are contending is, however, well recognized in the Patent Office and there are many Patent Office decisions that show that the principle is fully understood and is intelligently applied to cases that come before the Board of Appeals or the Commissioner. A few illustrative cases may be cited.

Among other claims which were before the Commissioner on Appeal in *ex parte Wigginton*, 279 O. G. 729 was the following claim:

> "31. The combination with loose sheets, of a holder comprising side and end members disposed at right angles, and a support associated with said holder to support the sheets at an acute angle to said end member."

The following excerpts from the opinion sufficiently recite the facts and the point decided:

> "The decision of the Examiners-in-Chief is based on the ground that the applicant is not entitled to these claims in view of the fact that he had already been granted a patent for the same invention.
>
> "It appears that this application as filed contained claims for the holder and claims, such as present claim 31, to the combination of this holder with loose sheets without in any way specifying the character of those sheets or how they coact with the specific holder. A requirement for division was complied with, and an

additional application was filed for the holder itself, which application has matured into Patent No. 1,270,-082, being the patent referred to by the Examiners-in-Chief.

"The question here is not whether the patent granted on the divisional application is prior art but *whether the appealed claims cover an invention different from that covered by the claim of the patent.*

" . . . this Office has no authority to grant two patents for the same invention. *The Office has held that the holder was an invention over the prior art; but certainly there was no further invention in using this holder for the purpose for which it was intended,* which is all that the appealed claims cover, since they specify merely the combination with loose sheets of a certain specific holder. These claims are thought to be clearly unpatentable in view of the ruling in *Underwood v. Gerber,* supra, which, it is thought, is not based merely on the ground that the earlier patent had not been put in suit, and in *Palmer Pneumatic Tire Co. v. Losier,* (90 Fed. Rep. 732)." (Italics ours.)

Another case exactly in point is that of *McBride v. Kroder,* 21 Gour. 84-9. The invention was a curtain pole fixture. This was claimed in combination with the door jamb or wall on which the fixture was to be supported. The Commissioner held that the combination of a door jamb and a curtain pole fixture was old and that no claim could be allowed for such old combination merely because the curtain pole fixture was novel; it being well settled that (italics ours)—

"where the combination as a whole is old, it is not rendered patentable by the substitution therein of a different element or elements (in this case the novel fixture) whether such element is in itself new or old" (*In re* McNeil, 100 O. G. 2178; 20 App. D. C., 294).

In *Ex parte Campbell,* 18 Gour. 6-12, a novel cuspidor was mounted detachably in a ring. It was old to mount cuspidors detachably in a ring. The Commissioner held, therefore, that there could be no invention in mounting the novel cuspidor in a ring, that no claim could be allowed therefor, and that——

> "an applicant who secures the allowance of claims to his real invention is not entitled to other claims for the use of that invention in connection with old features of construction which are common in the art."

The classic decision of the Commissioner of Patents constantly cited to solicitors practicing before the Office, is *Ex parte* McNeil, Commissioner's Decisions, 1902, page 313, 100 Official Gazette, 1976. In that case the applicant claimed, in a sewing machine, the combination with an old trimming device of a particular stitch-forming mechanism which he asserted was new with himself. The Commissioner stated:

> "Borton and Willcox having invented the combination of a trimmer with a stitch-forming mechanism, it is not invention to combine a trimmer with another stitch-forming mechanism whether the stitch-forming mechanism be new or old. . . . If appellant regards himself to be the original inventor of the particular stitch-forming mechanism shown and described, he should claim it."

We have deemed it unnecessary to explain the application of each of the foregoing decisions to the present case, their identity in principle being obvious.

It is assumed that plaintiff-petitioner will rely upon the decision of this Court in the *Leeds and Catlin v. Victor Talking Machine Co.* cases, 213 U. S. 301 and 325. The patent involved in these cases related to talking machines and was

for the combination of a stylus and diaphragm with a disc record. Both elements were novel but neither possessed any utility without the other. The stylus and diaphragm differed from that of the prior art in that they were not actuated by feed mechanism but were freely movable laterally. The disc differed from the prior art in that it had grooves of a peculiar character, to the lateral undulations of which, in the rotation of the disc, the diaphragm and stylus freely conformed. Each element was necessary to the operation of the other. The invention did not consist, as in claims 14 and 15 of the instant case, of an improvement of merely one element of an old combination. The patentee did not claim, as a new combination, an old combination, one element of which was improved. There were not two patents, one for the disc or for the diaphragm and stylus and the other for the combination. There was but one invention and but one patent, and that patent was for a new combination in which the elements coöperated with the result of a new mode of operation not characteristic of pre-existing talking machines.

The defendant manufactured disc records, of the character of that defined in the combination claimed, ostensibly for use with its own reproducing device but actually for use in connection with the Victor Company's talking machine which embodied the freely laterally movable diaphragm and stylus of the patented combination.

In the original case involving the patent in suit, it was decided by the Court of Appeals for the Sixth Circuit (*Lyman, et al. v. Bassick*, rendered March 23, 1927, 18 Fed. 2d 29), that the case before it was controlled by the *Leeds and Catlin v. Victor Talking Machine Co.* case. We see no occasion to go into a detailed review of the facts and evidence that were before the Court in that case and which, in

the opinion of the Court, presented some analogy to the talking machine case. It suffices to say that the facts and evidence upon which the charge of infringement in *Lyman et al. v. Bassick* was based were essentially different from the facts in evidence upon which the charge of infringement was based in the instant case. We need only to refer to the significant fact that this same Circuit Court of Appeals in the instant case refused to find *Leeds and Catlin v. Victor Talking Machine Co.* controlling.

Leeds and Catlin v. Victor Talking Machine Co. was also considered by the Court of Appeals for the First Circuit in *Alemite v. Lubrair,* 62 Fed. 2d, 899, which involved only claims 14 and 15 of the patent in suit. The Court, commenting upon the decision in *Leeds and Catlin v. Victor Talking Machine Co.,* said (p. 901):

> "The disc was useless except in combination with the reproducing mechanism. It was the combination which produced the result, and carried out the invention of the patent—a very different situation from that presented here where the combination alleged to infringe accomplishes no new result. The broad expressions in the opinion are to be read with the facts in mind and as limited by the Carbice Corp. Case, supra."

In *Alemite v. Lubrair,* 62 Fed. (2nd) 899, the decision was in conformity with the decision of the Court of Appeals for the Sixth Circuit in the instant case, the Court holding that there is no invention in combining the separately patented grease cup with a grease gun, except perhaps with the specific grease gun of the patent in suit, and that claims 14 and 15, unless construed to be so limited, are invalid.

Even in the *Leeds & Catlin* case, the broad question whether defendant-petitioner could legally sell unpatented

disc records, if they were intended and adapted for use with the talking machines of the plaintiff-respondent, was not directly decided. See page 337. There were two cases presented for the decision of this Court. In the first case, 213 U. S. 301, the only question presented was whether claims 5 and 35 were valid. No question of contributory infringement arose. In the second case, 213 U. S. 325, the defendant-petitioner had been enjoined from infringing these claims. The District Court, affirmed by the Circuit Court of Appeals, adjudged the defendant-petitioner guilty of contempt of court for violating the injunction restraining the defendant from infringing claims 5 and 35. The Supreme Court held (p. 337) that it was unnecessary to consider the broad question whether disc records, being unpatented articles of commerce, could be legally sold by the petitioner, since "the facts of the case exclude petitioner from the situation which is the foundation of the contention".

We need not, and do not, go so far as to contend that a patentee can never have separate valid claims, or possibly even separate patents, for a new combination and for a new element of that combination. If the combination produces a new mode of operation or result as such, independent of or additional to the new mode of operation or result of the new element *per se,* there may be, conceivably, two inventions and therefore two valid claims, one for the new element and one for the new combination. But we need not discuss this question, since the instant case presents no such situation. The mode of operation of an old or unpatented grease-gun and the result produced thereby, when applied to the patented grease-cup, are precisely the same as its mode of operation when and result applied to grease-cups of the prior art. As was held by the Circuit Court of

Appeals for the First Circuit in *Alemite v. Lubrair,* 62 Fed. Rep. (2d) 899 (900):

> "As has been said, pressure grease cups were old in the art. All of them were intended to be used with a grease gun, which could be temporarily connected to supply lubricant. The combination of a Gullborg grease cup with an unpatented grease gun has no new action or advantage, except such as is furnished by the improved grease cup. It lacks the more effective action of the Gullborg cup and Gullborg gun. Given the Gullborg cup, we are unable to see any invention in combining it with a grease gun, except perhaps with the Gullborg gun. The claims in suit seem to us clearly invalid unless restricted to such a combination. In any event the combination of the Gullborg cup with a grease gun was within the scope of the patent on the cup, not of the patent on the improved gun. The case seems to us similar in principle to Heald v. Rice, 104 U. S. 737, 26 L. Ed. 910; Underwood v. Gerber, 149 U. S. 224, 13 S. Ct. 854, 37 L. Ed. 710; Morgan Envelope Co. v. Albany Perforated Wrapping Paper Co., 152 U. S. 425, 14 S. Ct. 627, 38 L. Ed. 500, and Carbice Corp. of America v. American Patents Development Corp., 283 U. S. 27, 51 S. Ct. 334, 75 L. Ed. 819. In the lower courts, Edison Electric Light Co. v. Peninsular Light, Power & Heat Co. (C. C. A.), 101 F. 831, and Radio Corp. of America v. Lord (C. C. A.), 28 F. (2d) 257, certiorari denied, 278 U. S. 648, 49 S. Ct. 83, 73 L. Ed. 560, may be referred to."

The concluding part of the opinion in the above case points out the analogy between cases where a plaintiff might seek to impose as a condition of its licenses under its grease-cup patent that only its own grease gun should be used therewith, which would hardly be permissible under the Clayton Act, and the attempt to secure the same result,

clearly contrary to public policy, by the subterfuge of claiming the new grease-cup in combination with any old grease gun. We submit that the following expression of opinion of this Court (p. 901) should have not only a powerful appeal to reason and common sense, but is in precise conformity to the long line of decisions which we have heretofore cited:

> "It is probable that under the Clayton Act (38 Stats. 730, § 3 [15 USCA § 14]) the plaintiff would not be permitted to impose as a condition of its licenses that its own grease gun should be used with the Gullborg grease cup, an indication of public policy which furnishes a reason for not construing the patent to accomplish that result unless the law so requires. This is probably so irrespective of the statute. See Carbice Corp. Case, supra; United Shoe Machinery Corp. v. United States, 258 U. S. 451-465, 42 S. Ct. 363, 66 L. Ed. 708, and Radio Corp. of America v. Lord, supra. It is highly undesirable that patents should be so construed and upheld as to give a monopoly on other things besides the subject-matter of the invention. Carbice Corp. Case, supra. In our opinion the law of contributory infringement has been carried quite far enough in the public interest. We are not disposed to extend it. As Judge Lowell said in the District Court, referring to the plaintiff's contention, 'It isn't what the patent was meant to be. It is contrary to the idea of patents.' From what has been said, it follows that in our opinion the District Judge was right in refusing to grant the injunction."

Conclusion.

We respectfully submit:

1. That the finding of fact by the Circuit Court of Appeals for the Sixth Circuit that the grease gun sold by the Hollingshead Company to Beezley was not of the "suction effect" type should not be disturbed.

2. That the sale by the Hollingshead Company of grease guns of this type did not constitute a contributory infringement of the Gullborg patent.

3. That the claims, and particularly claims 14 and 15, of the Gullborg patent are invalid.

4. That plaintiff-petitioner is with legal right, under the patent in suit, to monopolize the manufacture, use or sale of old or unpatented grease guns.

Respectfully submitted,

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